

Our Reference No. 4320-091

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

RABIE et al.

Serial No. 09/425,234

Filed: October 25, 1999

For: **MAINTENANCE CLEANING
FOR MEMBRANES**

Art Unit: 1724

Examiner: POPOVICS, Robert J.

The Commissioner of Patents
& Trademarks
Washington, D.C. 20231
U.S.A.

RECEIVED

June 10, 2003

JUN 11 2003

OFFICE OF PETITIONS

Dear Sir:

PETITION UNDER 37 CFR §1.313

The Applicants hereby petition pursuant to 37 CFR §1.313 that this application be withdrawn from issue. With reference to 37 CFR §1.313(c)(2), the Applicants have filed a Request for Continued Examination concurrently with this petition. The Request for Continued Examination includes a Supplemental Information Disclosure Statement including (a) prior patents or publications, (b) a declaration of Ake A. Deutschmann, and (c) reports of other examiners regarding claims related to those in the present application.

Regarding the prior patents or publications cited in the Information Disclosure Statement, these references fall into two categories. The first category includes all but one of the references. The Applicants previously attempted to submit these references on the same day as submitting an Information Disclosure

06/12/2003 CKHLCK 00000009 09425234

01 FC:1460	130.00 0P
02 FC:1801	750.00 0P

please send your reply to

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Statement in another application having a consecutive serial number, US 09/425,235. The references were considered in US 09/425,235. However, on further review of their files, the Applicants now believe that their prior submissions were not successful in this application and that those references have not been considered by the Examiner.

The second category includes U.S. Patent No. 6,331,251. U.S. 6,331,251 is based on the same application as U.S. 6,210,582. During the prosecution of this application, U.S. 6,210,582 was cited in an Office Action. After that citation, U.S. 6,210,582 was withdrawn with the effect that it had never issued. U.S. 6,331,251 was later issued in its place. The Applicants responded to the Office Action making reference to U.S. 6,331,251 in response to the citation of U.S. 6,210,582. However, in the course of these confusing events, the Applicants did not list U.S. 6,331,251 on an Information Disclosure Statement and the Examiner did not list it on a form PTO-892. As a result, the Applicants believe that U.S. 6,331,251 has not been properly cited as a reference.

Regarding the declaration, Ake A. Deutschmann is a co-inventor of U.S. Patent No. 5,403,479, one of the patents referred to in the Information Disclosure Statement. His declaration was prepared after the Applicants paid the issue fee in this case for use in U.S. Application Serial No. 09/916,247, which is a continuation-in-part of the present case. His declaration contains information regarding the results of a pilot plant test referred to in U.S. Patent No. 5,403,479. In combination with other information found in U.S. Patent No. 5,403,479, information in Mr. Deutschmann's declaration relates to limitations found in the claims of the present application.

Regarding the reports of other examiners, these reports consider the patentability of claims or comment on the relevance of the art to claim limitations related to those in the present application. These reports include Office Actions in U.S. Application Serial No. 09/916,247, which is a continuation-in-part of the present case, and PCT/CA00/00876 which is a PCT equivalent of the present case. Pursuant to the recent decision of the Court of Appeals for the Federal Circuit in *Dayco Products, Inc. v. Total Containment, Inc.*, 2003 U.S. App. LEXIS 10374, these reports may meet the materiality standard under Rule 56. The decision in *Dayco Products, Inc. v. Total Containment* is dated May 23, 2003, which is after the Applicants paid the issue fee in this application.


The Applicants submit that one or more of the items cited in the Information Disclosure Statement are material to the patentability of the claims in the present

application and should be considered by the Examiner before this application issues.

For the reasons above, the Applicants submit that this petition shows good and sufficient reason why withdrawal of the application from issue is necessary and respectfully request that the application be withdrawn from issue.

Respectfully submitted,

RABIE et al.



Scott R. Pundsack
Registration No. 47,330



June 10, 2003

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Your Reference: 09/425,234

Our Reference: 4320-91

PETITION UNDER 37 CFR 1.313

MAIL STOP 313(C)

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22323-1450

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JUN 11 2003

OFFICE OF PETITIONS

Dear Sir:

Re: United States Patent Application No. 09/425,234
For: MAINTENANCE CLEANING FOR MEMBRANES
Filing Date: October 25, 1999
Applicants: Hamid Rabie et al.
Group: 1724

Enclosed is a Petition Under 37 CFR 1.313^(c) to withdraw this application (US Patent Application No. 09/425,234) from issue. The issue fee was paid in this application on January 29, 2003. Accordingly, the Applicants respectfully request that this Petition be considered as soon as possible since this application might otherwise issue shortly.

Pursuant to 37 CFR 1.313(c)(2), this Petition to withdraw from issue is being filed with a Request for Continued Examination in compliance with 37 CFR 1.114. With reference to 37 CFR 1.114, an Information Disclosure Statement is filed herewith as the submission required to support the Request for Continued Examination. The fees required under 37 CFR 1.17(h) for the Petition and under 37 CFR 1.17(c) for the RCE are also being filed herewith.

The Information Disclosure Statement filed as the submission supporting the Request for Continued Examination contains references which the Applicants submit are material to the patentability of the present application. The citation of references was difficult in this case because it was proceeding simultaneously with two related cases having

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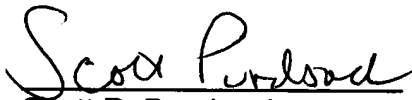
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consecutive serial numbers, US 09/425,235 and 09/425,236. Also, one of the references was withdrawn with the effect of never having issued and replaced with a new patent during the prosecution of this application. As a result, the Applicants believe that some references have not been properly cited or considered by the Examiner. New information has become known to the Applicants in a continuation-in-part of the present application. Finally, a recent decision of the C.A.F.C suggests that the Examiner's comments in certain related applications should be considered by the Examiner in the present application.

The Applicants respectfully submit that the Petition shows good and sufficient reasons why withdrawal of this application from issue is necessary and request that the Petition be considered prior to the issuance of this application.

Respectfully submitted,
RABIE et al.


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/jw